



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/737,687 | 12/14/2000 | Darin Arthur Allen | 218 | 1550 |
| 7590 | 04/05/2005 | | EXAMINER | |
| Axys Pharmaceuticals, Inc. 180 Kimball Way South San Francisco, CA 94080 | | | | POWERS, FIONA |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1626 | |

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/737,687 | ALLEN ET AL. |
| | Examiner | Art Unit |
| | Fiona T. Powers | 1626 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

Disposition of Claims

4) Claim(s) 1-8 and 10-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-8, 11-15 and 17 is/are rejected.

7) Claim(s) 10 and 16 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____ .

Art Unit: 1626

Receipt is acknowledged of the response filed February 23, 2004, which has been entered in the file.

In view of the petition decision mailed March 3, 2005, the entire scope of the claims has been examined.

Claim 1 is objected to because of the following informalities: variable R⁵³ is defined twice in the claim. Once with R⁶ and R⁹ then it is also defined right before the proviso. One of these definitions should be deleted. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 to 8, 11 to 15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because variables "X", "het" and "Ar" are not defined.

Note that the following rejections are made assuming X is carbon.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 to 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Stecker (US 2906711) or Stecker (US 3281466) or Wermuth et al (US 3793458), cited.

The references disclose the claimed compounds of the formula I wherein R¹ is OH or COOH, R²-R⁵ are independently H or halogen, R²⁰ is H, R⁵¹ and R⁵² together form =O, X, X₁, X₂, X₃ and X₄ are carbon and R⁶, R⁷, R⁸, R⁹ and R⁵³ independently represent H, alkyl, hydroxy, alkoxy, halogen or haloalkyl. Note Examples 1 and 2 and column 2, line 69 to column 3, line 3 of Stecker (US 2906711); Compound Nos. 1 to 13 of Stecker (US 3281466); and Examples 1 to 4 of Wermuth et al.

Applicant's arguments filed February 23, 2004 have been fully considered and the entire scope of the claims is being examined.

Claims 10 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fiona T. Powers
Fiona T. Powers
Primary Examiner
Art Unit 1626

Application/Control Number: 09/737,687
Art Unit: 1626

Page 5

ftp
March 30, 2005